

## REMARKS

In view of the foregoing amendments, the following remarks and the accompanying Supplemental Declaration of Lisa Osborne Connolly, reconsideration of Examiner's Office Action dated January 15, 2010, is hereby requested.

### **Status of the Claims**

Claims 1-35 are pending in this application, all of which currently stand rejected.

With this paper, Applicant amends independent claims 1, 15, and 23, and cancels claims 2 and 20. No claims have been added.

### **Interview Summary**

Applicant wishes to thank the Examiner for the courtesies she extended to Applicant and the undersigned during the Examiner Interview held on January 6, 2010. (Applicant attended in person and the undersigned attended by telephone.) During the interview Applicant demonstrated for Examiner her prior art Hair Accordion double comb hair accessory product and her current Hairzing product, which is the subject matter of the claims of the present application. Claims 1 and 32 were discussed as well as the Suzuki reference and Applicant's Rule 132 declarations. Possible further claim amendments regarding adding the wire loop comb feature to claims 1, 15 and 23 were also discussed. No agreement was reached regarding the claims.

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In her Office Action dated January 15, 2010, the examiner has raised a new ground of rejection as to all of the claims, namely, an on-sale bar rejection under 35 U.S.C. §102(b), and repeats her previous rejections based on the prior art. The

Examiner has also given no weight to Applicant's Rule 132 declarations and the objective evidence of non-obviousness contained therein. Applicant will address the Examiner's on-sale bar rejection and prior art rejections below. In addressing the Examiner's prior art rejections, Applicant will focus on the Examiner's treatment of Applicant's Rule 132 declarations and the sufficiency thereof as objective evidence of non-obviousness. Rather than repeat the remarks contained in Applicant's prior response filed December 10, 2009, Applicant incorporates those remarks herein by reference.

**Rejections under 35 U.S.C. §102**

1. Claims 1-35 stand rejected under 35 U.S.C. §102(b) based on the declaration of Lisa Osborne Connolly ("Connolly Declaration").

The Examiner has interpreted paragraphs 9-12 of the Connolly Declaration filed December 15, 2009, as giving rise to an on-sale bar in respect to the claimed invention. According to the Examiner, Ms. Connolly's declaration indicates that a complete product in accordance with the invention was offered "for sale or licensing [one] year prior to [Applicant's claimed priority] date of 4/27/2003." Applicant submits that the facts declared to in Ms. Connolly's declaration, on their face, do not give rise to an on-sale bar, because they do not evidence an "offer for sale" as interpreted by the USPTO or the courts. Nevertheless, Applicant offers herewith a supplemental declaration by Ms. Connolly to dispel any ambiguity that might exist regarding the purpose of Ms. Connolly's evaluation of samples of Ms. Kuglen's invention, namely, that Goody Products was only considering a possible licensing arrangement with Ms. Kuglen with

respect to her invention. As made clear by Ms. Connolly's supplemental declaration, Applicant never offered to sell to Goody products made in accordance with her invention.

To trigger a on-sale bar under 35 U.S.C. § 102(b), the invention must be the subject of a commercial offer for sale. M.P.E.P. § 2133.03(b). To be a commercial offer for sale, the offer must be definite and capable of being accepted.

M.P.E.P. §2133.03(b)(II); *Group One, Ltd. v. Hallmark Cards, Inc.*, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001). A "communication that fails to constitute a definite offer to sell the product and to include material terms is not an 'offer' in the contract sense."

M.P.E.P. § 2133.03(b)(II)(D) quoting from *Elan Corp., PLC v. Andrx Pharms. Inc.*, 70 USPQ2d 1722, 1728 (Fed. Cir. 2004). Material terms that one would expect to find in a commercial offer for sale include product pricing, quantities to be purchased, and delivery terms. *Elan Corp, supra*.

Nowhere in Ms. Connolly's original declaration, and particularly the referenced paragraphs of her declaration, is there a semblance of terms of an offer for sale, much less a definite offer capable of being accepted. There is no mention of pricing or quantities, or any sort of delivery terms, or even Ms. Kuglen's capability to deliver products in accordance with the invention in commercial quantities. In short, as a matter of contract law, there simply was no commercial offer.

Nonetheless, Ms. Connolly's Supplemental Declaration makes clear that the reason Ms. Connolly's evaluated samples of Ms. Kuglen's invention was to evaluate whether Goody wished to negotiate an exclusive license for this new product design, not

whether they wished to use Ms. Kuglen as a supplier of the product. (Connolly Supplemental Declaration, ¶2.) Negotiating license rights in an invention for possible future sale of the invention by the perspective licensee does not give rise to an on-sale bar. M.P.E.P. § 2133.03(b)(I)(D) (“licenses that merely grant rights in an invention ... do not *per se* trigger an on-sale bar.”) As stated by Federal Circuit in *Group One, Ltd.*, *supra*, “the statute refers to a patented invention being on sale, not to an agreement with another party concerning the commercialization of the invention at some future time, following which the invention would then be placed on sale.” As clearly evidenced by the declarations of record, Ms. Kuglen and Goody were only interested in a possible licensing arrangement, wherein Goody would commercialize Ms. Kuglen’s invention at some future date.

For at least these reasons, it is respectfully submitted that claims 1-35 are not subject to an on-sale bar. Applicant therefore respectfully requests that the on-sale bar rejection of claims 1-35 under 35 U.S.C. § 102(b) be withdrawn.

2. Claims 1 and 6 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 1,665,380 to Ruffio (“Ruffio”).

To expedite to prosecution of this application, Applicant has amended claim 1 to recite that a row of looped wires are attached to and project from the spines of the opposed combs to form the teeth of the comb. Wire loop combs as now recited in claim 1 are not disclosed by Ruffio.

For at least these reasons, it is respectfully submitted that claims 1 and 6 are not anticipated by Ruffio. Applicant therefore respectfully requests that the Examiner’s

rejection of claims 1 and 6 under 35 U.S.C. § 102(b) based on Ruffio be withdrawn.

**Claim Rejections under 35 U.S.C. §103**

1. Claim 32 stands rejected under 35 U.S.C. §103(a) as being unpatentable over USP 6,123,086 (Kuglen) in view of JP #409299131A (Suzuki).

Claim 32 recites a stretch comb hair retainer which include two opposed wire combs, wherein each of the combs has a metal spine defining the width of the comb and a row of looped wires attached to and projecting from the comb's metal spine to form parallel projecting teeth of the comb. The Examiner has repeated her rejection of claim 32 based on a combination of Kuglen and Suzuki and her contention that it would have been obvious to one of ordinary skill in the art at the time the invention was made to simply substitute the wire loop comb disclosed by Suzuki for the non-wire combs disclosed in Kuglen. Citing the recent Supreme Court decision in *KSR International Co. V. Teleflex Inc.* 82 USPQ 1385 (2007), the Examiner again states that this substitution would produce predictable results.

In repeating her rejection of claim 32 (as well as other claims of the application), the Examiner has dismissed the most recent Rule 132 declarations submitted by Applicant as objective evidence that such a combination would not have been obvious and that such a substitution would not have been predictable.<sup>1</sup> First, the Examiner states that the recently submitted declarations amount to nothing more than an affirmation that the claimed subject matter functions as it was intended to function.

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<sup>1</sup> Declarations of Masaaki Suzuki, Laurie Erickson, Lisa Osborne Connolly, Connie Stewart, and Stan Reyes were submitted with Applicant's response filed December 10, 2009.

Second, the Examiner states that the declarations refer only to the whole device described in applicant's specification and not the individual claims. Respectfully, Applicant disagrees.

In claim 32, as well as in the balance of the claims as now amended <sup>2</sup>, the claimed subject matter includes two opposed combs, each having a row of looped wires attached to and projecting from the comb's spine to form parallel projecting teeth of the comb ("wire loop combs"), in combination with elastic strands extending between and secured to the spines of the combs. The submitted declarations address the use of wire loop combs in this claimed combination.<sup>3</sup>

Specifically, the submitted declarations provide evidence as to the following :

- 1) Unexpected (unpredictable) results as to this claimed subject matter.
- 2) The error in the examiner's premise that using wire loop combs disclosed in Suzuki in place of the non-wire combs of a double comb accessory as disclosed in Kuglen is a simple substitution of known elements.
- 3) Copying by others as to this claimed subject matter.
- 4) Commercial success as to this claimed subject matter.
- 5) The level of skill in the art as to this claimed subject matter.

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<sup>2</sup> Claim 32 recites that the spines of the combs are metal. Other claims do not.

<sup>3</sup> Applicant wishes to stress again that the question presented is whether the use of a wire loop comb as taught by Suzuki in a double comb hair accessory as taught by Kuglen would have been non-obvious to a person of ordinary skill in the art at the time the invention was made, not whether there are non-obvious differences between the wire loop comb taught by Suzuki and the wire loop combs recited in Applicant's claims.

While the declarations of record should be read as a whole, Applicant points to the following as examples of evidence and excerpts from the declarations of record that support the foregoing points:

### **Unexpected Results**

Masaaki Suzuki --

(Background: hair accessory designer and inventor of the Hair Ornament disclosed in the Suzuki reference cited and applied by the examiner.)

“[A wire loop comb] is relatively weak compared to other combs, such as plastic and wood combs. A wire loop comb will fall out of the hair if a woman simply puts it in the hair, especially if the hair is short.” (¶7)

“Until Ms. Kuglen’s invention, wire loop combs were, to my knowledge, only used a single combs to decorate the hair. I would never have thought that wire loop combs would work when used in the way Ms. Kuglen uses them in her Hairzing product.” (¶8, emphasis added)

Ms. Kuglen’s discovery was that wire loop combs could perform a hair retaining function when used as double combs that are being pulled together by stretch elements. (¶9)

Laurie Erickson --

(Background: hair accessory designer and owner of hair accessory business.)

“By themselves, wire loop combs are not strong and lack stability. Thus, they are not a good solution for holding hair in place.” (¶6)

“Because of their physical characteristics and tendency to fall out of the hair, I would not have thought to use wire combs for the purpose or predicted that they would have worked in this application [Ms. Kuglen’s invention]. Before I became aware of the use of wire loop combs in this application, I would have thought that the elastic strands pulling on the comes would pull the combs out of the hair.” (¶7, emphasis added)

Francesca Kuglen/Applicant (Declaration filed January 7, 2009) --

Provides evidence of the following consumer comments related to wire loop combs (¶16):

“Was I surprised when those little bitty wire combs were strong enough to hold all this! I still can’t believe it.”

“I have NEVER felt a comb that holds like Hairzing does! Why hasn’t anyone ever made a product like this before.”

“When I first saw Hairzing I thought it look so flimsy, it would never hold.” ...  
“I cannot stop talking about how strong and comfortable it holds, I have never felt anything like this before.”

Stan Reyes (Mechanical engineer. Test results on wire versus plastic combs) --

Provides evidence that the wire loop combs do not hold well in any tested hair volume. Supports unexpected result, namely, it would not be expected that wire loop combs would actually hold in Applicant’s claimed combination.

### **Error in Examiner’s Simple Substitution Premise**

Masaaki Suzuki --

“Before seeing Ms. Kuglen’s Hairzing accessory product, I would have never considered using wire loop combs in a double comb hair accessory where the combs are held together by elastic strands or bands.”

Laurie Erickson –

“Different combs have different characteristics, including the width, thickness, the number of teeth, tooth construction ... and the materials used.” The physical characteristics of the comb are important because they affect how the comb will function in the hair. For a particular application, I would not consider simply substituting one type of comb for another type of comb. Combs having significantly different physical characteristics behave much differently in the hair.” (¶5)



“Wire loop combs are peculiar combs having characteristics somewhat like a row of bobby pins.” (¶6)

Connie Stewart –

(Background: Designer of hair accessory products)

“I consider Ms. Kuglen’s Hairzing product to be a very unique product. I believe her use of wire loop combs to be unusual. Wire is soft and bendable and I would not have thought to use wire combs for a double hair accessory product like Hairzing.” (¶9)

### **Copying by Others**

Francesca Kuglen/Applicant (Declaration filed January 7, 2009) – evidence of widespread copying by others found at paragraph 17 of declaration.

### **Commercial Success**

Francesca Kuglen/Applicant (Declaration filed January 7, 2009) – evidence of commercial success of Applicant’s own product in accordance with the claims is found at paragraphs 13 and 14.:

- Over 500,000 units sold as of the date of the declaration.
- Informed that, as of October 2008, it was the most successful hair accessory sold on QVC.

Connie Stewart – evidence of enormous commercial success of copy of Applicant’s invention as claimed (EZ Combs sold by Telebrands) is found at paragraph 8:

- 7 million units sold by Telebrands.
- a very successful product of Telebrands, even in a recessionary economy.

**Level of Skill in the Art**

Masaaki Suzuki -

“Many hair accessory designers can create the ornamental parts for an accessory, but few designers have the skill and experience to design new and original holding devices to properly retain hair and satisfy different ways and conditions in which combs are used. In my experience such a designer is very difficult to find.” (§10)

Laurie Erickson –

“I would describe the hair accessory business as a craft business and the hair accessory design process as an organic one. The ordinary designer of hair accessory products is not technically inclined or inclined to make significant changes in product function. Designers in our field generally focus on the aesthetic and create new decorative elements that are added onto an existing base, such as a barrette, headband or comb.” (§4)

Lisa Osborne Connolly –

“At the time I saw Ms. Kuglen’s beaded double comb hair accessory product, I had never seen anything like it before and thought it was very innovative. One of the innovative features was the use of wire loop combs. Product designers in this field typically do not have a high level of design skill, and I don’t believe any of the product designers at Goddy would have come up with Ms. Kuglen’s unique product design or the idea of using wire loop combs in a double comb hair accessory application.” (§11, emphasis added)

Taken together, these declarations establish the following:

1. Different types of combs have different characteristics and behave differently in the hair.
2. One type of comb cannot be simply substituted for another type of comb in a particular application with the expectation that the substitution will be useful or will work.

3. Wire loop combs behave much differently in the hair than other types of combs, such as plastic combs.
4. Wire loop combs by themselves do not hold well in the hair and are relatively unstable in the hair.
5. At the time the invention was made, it would not have been predictable that wire loop combs would have worked in a double comb hair accessory (e.g. "I would have thought that the elastic strands pulling on the comes would pull the combs out of the hair", Laurie Erickson).
6. At the time the invention was made, the fact that the wire loop combs actually work well to hold a double comb hair accessory in place in the hair was a surprising and unexpected result.
7. Applicant's invention as claimed has been widely copied by others.
8. Hair accessory products in accordance with applicant's invention as claimed have met with enormous commercial success in the marketplace.
9. The level of skill in the field of hair accessory design is relatively low.

In light of the foregoing, Applicant respectfully requests reconsideration of the Rule 132 Declarations of record, and that proper weight be accorded these declarations as objective evidence of non-obviousness as to the combination of Suzuki with USP 6,123,086 to Kuglen, and the other prior art of record.

For at least these reasons and the reasons provided in Applicant's prior response, Applicant respectfully requests that the Examiner's rejection of claim 32 under 35 U.S.C. 103(a) be withdrawn.

2. Claims 26, 29, and 32-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over USP Design 483,522 (Leslie) in view of Kuglen and JP '131.

Regarding claims 29 and 32-35, these claims all contain the limitation that the combs have wire loop teeth. Thus, the foregoing remarks and Applicant's evidence of non-obviousness related to claim 32 equally apply to these claims.

Regarding claim 26, Applicant believes the inclusion of this product-by-process claim may have inadvertently been included in this rejection. It is noted that this claim, which is now subject to the Examiner's on-sale bar rejection discussed above, was previously considered allowable over the prior art of record,<sup>4</sup> and that the Examiner offers no comment on the process limitations in this claim.

3. Claims 1-25, 27-28, and 30-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Leslie in view of Kuglen and JP '131 as applied to claim 32, and further in view of USP 1,564,079 ("Lorbiecki").

Regarding claims 1-25 and 30-31, independent claims 1, 15 and 23 have been amended to recite combs with wire loop teeth, and previously presented claims 30-31 contain this limitation. Thus, the foregoing remarks and Applicant's evidence of non-obviousness related to claim 32 equally apply to these claims.

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<sup>4</sup> See Office Action dated March 17, 2009.

Regarding claims 27-28, Applicant believes the inclusion of these product-by-process claims may have inadvertently been included in this rejection. It is noted again that these claims, which are also subject to the Examiner's on-sale bar rejection, were previously considered allowable over the prior art of record, and the Examiner offers no comment on the process limitations in these claims.

For at least the foregoing reasons, Applicant respectfully requests that the Examiner's rejection of claims 1-25, 27-28, and 30-31 under 35 U.S.C. § 103(a) be withdrawn.

**Conclusion**

In view of the foregoing amendments and remarks, and the remarks provided in Applicant's prior response, and subject to the Examiner's clarification of her rejection of claims 26-28, Applicant submits that the present application is in condition for allowance, a request for which is hereby respectfully made.

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Respectfully Submitted,

/Donald L. Beeson/  
Reg. No. 27,692  
BEESON SKINNER BEVERLY, LLP  
One Kaiser Plaza, Suite 750  
Oakland, California 94612  
Tel: 510-832-8700  
Fax: 510-836-2595  
Email: [bsb@bsbllp.com](mailto:bsb@bsbllp.com)